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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,553	09/30/2003	Erik J. van der Burg	3791	5764

21834 7590 08/24/2009

BECK AND TYSVER P.L.L.C.
2900 THOMAS AVENUE SOUTH
SUITE 100
MINNEAPOLIS, MN 55416

EXAMINER	
HORNBERGER, JENNIFER LEA	
ART UNIT	PAPER NUMBER
3734	

MAIL DATE	DELIVERY MODE
08/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/674,553	VAN DER BURG ET AL.	
	Examiner	Art Unit	
	JENNIFER L. HORNBERGER	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5, 38-50,55-61,63,64,66-71, 85-91, and 120-180* is/are pending in the application.

4a) Of the above claim(s) *44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims rejected are 38, 40, 45, 48-50, 55-61, 64, 85, 89, 90, 91, 120, 125, 133, 134, 136, 138, 144-148, 150-153, 155- 157, 170-173 and 176-180 .

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/187,200, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application fails to provide support for "the device at least partially prevents passage of embolic material from the left atrial appendage by supporting tissue growth." Accordingly, claims 50, 55, 64, 91, 127, 133, 139, 144, 152, and 157 are not entitled to the benefit of the prior-filed application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 50, 55, 64, 91, 127, 133, 139, 144, 152, and 157 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Tassel et al. (US 6,551,303).

Van Tassel et al. disclose a method of preventing passage of embolic material from a left atrial appendage of a patient (col. 6, ln. 10-19), comprising: providing a deployment catheter (21) having an elongate flexible body with a proximal and distal end, and an implantable device removably carried by the distal end, said device comprising a barrier (40), said device radially expandable from a reduced diameter to an enlarged diameter and configured to conform to an inside surface of the left atrial appendage (col. 6, ln. 28-58, col. 7, ln. 7-62; Figures 5-9); positioning the barrier adjacent an interior opening of the left atrial appendage by passing the device through the ostium and into in the left atrial appendage; and enlarging the device within the left atrial appendage (col. 6, ln. 28-58), and engaging anchoring elements with the tissue within the interior surface of the left atrial appendage (col. 7, ln. 12-14) , wherein said barrier extends across the left atrial appendage when enlarged so that the device circumferentially seals against the inside surface of the left atrial appendage to prevent passage of embolic material, and wherein the deice at least partially prevents passage of embolic material from the left atrial appendage by supporting tissue growth (col. 5, ln. 50-55).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 38, 40, 55, 56, 58, 60, 61, 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements of the pending claims are found in claim 7 of the patent. The difference between claim 38, 40, 55, 56, 58, 60, 61, 64 of the application and claim 7 of the patent lies in the fact that the patent claim is more specific. For example, the patent claims a method of securing a porous membrane, encouraging endothethial cell growth, over an ostium of the atrial appendage by extending prongs into the atrial appendage wall and blocking the ostium with the membrane preventing thrombus from leaving. The instant application claims positioning a porous barrier adjacent an interior opening of the atrial appendage, and engaging at least on anchoring element with the interior surface of the atrial appendage to hold the device in place, wherein the anchoring element is connected to the barrier to hold the barrier adjacent the opening and prevent passage of material from the left atrial appendage. Thus, the invention of patented claim 7 is a species of generic invention in application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 40, 55, 56, 58, 60, 61, 64 are anticipated by claim 7 of the patent, it is not patentably distinct from patented claim 7.

6. Claims 45, 38, 56, 59, 60, 134, 136, 138 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of **U.S. Patent No.**

6,551,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claim 5 of the patent.

7. Claims 49, 56, 57, 58, 128m 170, and 176-178 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claim 14 of the patent.

8. Claims 85, 89, 90, 120, 125, 145-148, 150, 151,153, 155, 156, 170-173 and 176-180 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claims 5 and 18 of the patent.

9. Claims 38, 45, 48, 56, 58, 59, 134, 136, 138, 170, 171, 173, 176-180 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of **U.S. Patent No 6,689,150**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claims claim 3 of the patent.

10. Applicant (or the assignee of this application if the assignee has undertaken the prosecution of the application) is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

11. There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11(a) subsection G, applicant (or the assignee) is respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of

applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obviousness type double patenting. For example, claims 38, 40, 45, 49, 55-61, 64, 85, 89, 90, 120, 125, 134, 136, 138, 145-148, 150, 151,153, 155, 156, 170-173 and 176-180 of application serial number 10/674,553 differ from claims 1, 5, 7, 14, 15, and 18 of application serial number 09/428,008 in only the fact that the patent claim is more specific. Thus, the invention of patented claims is a species of generic invention in application claims. It has been held that the generic invention is anticipated by the species. Because the applicant (or the assignee) is presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims.

12. Should applicant (or the assignee) believe that Double Patenting exists, then applicant (or the assignee) is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application. Applicant (or the assignee) should note that a terminal disclaimer is effective to overcome an obviousness type double patenting rejection, but will not overcome a "same type" double patenting rejection under 35 U.S.C. 101

13. Non-exhaustive list of possible related co-pending applications and patents:

09/187,200
09/399,521

09/428,008
09/614,091
09/642,291
09/825,647
09/960,749
10/033,371
10/351,736
10/426,107
10/426,130
10/441,718
10/642,384
10/810,990
10/830,964
10/997,804
11/003,696
11/009,392
11/229,313
11/401,199
11/434,012
11/607,638
11/607,769

Response to Arguments

14. Applicant's arguments, see pages 12-14, filed 04/24/09, with respect to claims 1-5, 38-49, 56-61, 63, 66-71, 85-90, 120-126, 128-132, 134-138, 140-143, 145-151, 153-156, 158-169, 170-180 have been fully considered and are persuasive. The rejection of 12/24/08 has been withdrawn.

Allowable Subject Matter

15. Claims 1-5, 38-43, 45-49, 56-61, 63, 66-71, 85-90, 120-126, 128-132, 134-138, 140-143, 145-151, 153-156, 158-169, 170-180 are allowable if all double patenting issues are overcome. None of the prior art discloses a method for preventing passage of embolic material from an atrial appendage of a patient comprising the step of positioning a device adjacent the ostium, the interior opening of the atrial appendage, and into the atrial appendage, wherein the device prevents passage of embolic material from the atrial appendage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh
08/16/2009

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734

/DONALD T HAJEC/
Director, Technology Center 3700